

REMARKS

Reconsideration of the application as amended is requested.

Applicants affirm the election of Species I (claims 1-22 and 66-67).

In the Office Action dated June 25, 2008, claims 2-4, 19, and 22 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. These claims have been amended to recite that the reduced contact area is a percentage of the contact area that would occur but for the interruption of continuity of contact. (i.e. "reduced" has been deleted to eliminate the reference to a reduction in area.) Support for these amendments can be found at, for example, page 9, lines 15-20 of the present application as filed. Applicants note that the specification specifically states that the percentage reductions are "compared to the contact area without such interruptions in continuity." It is clear from the disclosure that a reduction in area of 10%, for example, compared to the contact area without interruption it is the same as positively reciting that there is a 90% contact area as compared to the contact area that would exist if there were no interruptions. Accordingly, claims 2-4, 19, and 22 are now believed to be clear and definite as required by 35 U.S.C. §112, second paragraph.

In the subject Office Action, claims 1-10, 12, 14-22, 66 and 67 were rejected under 35 U.S.C §102(b) as being anticipated by Heinecke et al. U.S. Patent No. 5,738,642, and claims 11 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Heinecke '642. Applicants respectfully assert that all of the pending claims, as amended herein, patentably distinguish over the cited references.

Claim 1 has been amended to recite that the handle is adhered to a second side of a polymeric film to define a non-use configuration, and wherein the handle can be separated from the polymeric film to define a transient configuration as the handle is being separated from the polymeric film. Claim 1 also recites that the continuity of contact between the handle and the polymeric film is interrupted when the device in the non-use configuration.

In contrast, the carrier 270 (Fig. 10) of Heinecke '642 is lifted from backing 214 at cut 250 in use, after the backing is applied to a patient. Heinecke '642 does not disclose interrupting the continuity of contact between a handle and a polymeric film other than in use,

as the carrier is peeled away. Applicants note that "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" MPEP 2112(IV), citing *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991))(emphasis added).

Also, Applicants appreciate that claims are broadly construed during prosecution. However, even during prosecution claim terms cannot be contorted without bound in an unreasonable manner: "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." MPEP 2111 (emphasis added). MPEP 2111.01(I) states that "words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification." Furthermore "'plain meaning' refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art." MPEP 2111.01(II).

Applicants respectfully assert that the plain meaning of the interruption of claim 1 would not include the cut 250 of Heinecke '642. There is no evidence of record that this proposed construction would be consistent with the interpretation that those skilled in the art.

Claims 2-22 depend from claim 1, and are therefore believed to be allowable for those reasons set forth above in connection with independent claim 1.

Also, with respect to claim 11, the cited references do not disclose knurling of a handle, such that no combination of the references can possibly anticipate claim 11. The only disclosure of knurling is Applicants own disclosure. Applicants note that "an inventor's own work may not be considered prior art by admission. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 136, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003); *See also In re Ehrreich and Avery*, 200 USPQ 504, 590 F.2d 902 ("a finding of obviousness should not be based on an implied admission erroneously creating imaginary prior art. . . . We will not use appellants'

claim preamble as prior art against them in this situation.") Treating applicant's disclosure of knurling as one choice among other prior art disclosures is clearly improper.

With respect to claim 13, none of the cited references disclose texturing that comprises a first adhesive coating being printed in a pattern on a first side of a handle. Thus, no combination of the cited references could possibly anticipate claim 13. Applicants reiterate that it is improper to treat the disclosure of the present application as prior art.

Independent claim 66 has been amended to recite interrupting the continuity of contact between a handle and a polymeric film prior to removal of the handle, thereby minimizing edge release of the film from the patient's skin or mucosa when the handle is removed. As discussed above in connection with claim 1, carrier 270 of Heinecke '642 is appealed from backing '214 as it is removed. This is directly contrary to the arrangement of amended claim 66.

Claim 67 has been amended to recite that the area of contact between a first adhesive coating and a polymeric film is reduced to about 30% to about 90% prior to bringing the second adhesive layer into contact with a patient. Applicants assert that this is directly contrary to the arrangement of Heinecke '642.

Applicants have also added new claims 71-73. Each of these claims is somewhat similar to original claim 1. Support for new claims 71-73 can be found in original claim 1, and in the specification at page 9, line 1 through page 11, line 32, and Figs. 1-14. New claim 71 recites that the handle defines an outer peripheral edge and an inner peripheral edge forming a window through the handle, and the handle includes a cut extending between and interconnecting the inner and outer peripheral edges. Claim 71 further recites that the continuity of contact between the handle and the film is interrupted by a deformation in the handle other than the cut.

New claim 72 recites that the handle defines an outer peripheral edge, and the continuity of contact is interrupted by a plurality of discrete openings in the handle defining edges that do not connect to the peripheral edge of the handle.

New claim 73 recites a handle defining a perimeter and a window through the handle. The handle also includes a tab projecting into the window. A polymeric film is adhered to the

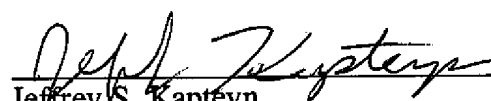
Applicant : Michael G. Marcoux et al.
Appln. No. : 10/563,340
Page : 12

handle, and the tab is adhered to the polymeric film substantially less aggressively than the perimeter is adhered to the polymeric film. New claim 74 depends from new claim 73, and recites that the device includes a layer of adhesive disposed between the handle and the polymeric file except at the tab. Support for new claim 73 can be found at page 8, lines 14-15 ("preferably, the underside of thumb tab 11 is not coated with adhesive").

Applicants have made a concerted effort to place the present application in condition for allowance. In the event there are any remaining informalities, the courtesy of a telephone call to the undersigned attorney would be appreciated.

Respectfully submitted,

Date 9/25/08



Jeffrey S. Kapteyn
Registration No. 41 883
Price, Heneveld, Cooper, DeWitt & Litton, LLP
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

JSK/slg